

REMARKS

As an initial matter, Applicant appreciates the Examiner's reconsideration and withdrawal of all of the claim rejections included in the Office Action dated December 13, 2004. Applicant also respectfully submits that all of the claim rejections included in the Office Action dated June 1, 2005, should be reconsidered and withdrawn, as outlined in more detail herein.

I. Claim Rejections under 35 U.S.C. § 103(a) based on Moyer and Pflueger et al.

In the Office Action, claims 1, 4, 5, 7-9, 11-15, and 19-26 were rejected under 35 U.S.C. § 103(a) based on Moyer (U.S. Patent No. 5,794,773) in combination with Pflueger et al. (U.S. Patent No. 6,123,198). Claims 1, 4, and 26 are the only independent claims rejected under § 103(a) based on the rejection statement's proposed, hypothetical modification to the Moyer reference's disclosure based on the Pflueger et al. reference, and Applicant respectfully traverses the rejection statement's proposed modification of Moyer's disclosure because there is no legally valid suggestion or motivation for making the modification. Therefore, the Office Action has failed to establish that any of Applicant's independent claims 1, 4, and 26 are *prima facie* obvious.

In order to establish a *prima facie* case of obviousness, among other requirements, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one having ordinary skill in the art, to modify the reference or to combine reference teachings." M.P.E.P. § 2142. In other words, "[t]he mere fact that references can be combined or modified does not

render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” Id. at § 2143.01 (citation omitted).

The Office Action fails to establish that Applicant’s independent claims 1, 4, and 26 are *prima facie* obvious at least because there is no suggestion or motivation to modify the Moyer reference’s disclosure relating to a bowling ball carrier in view of the Pflueger et al. reference’s disclosure relating to a cosmetic carrier in the hypothetical manner proposed in the rejection statement. Accordingly, Applicant’s independent claims 1, 4, and 26 are not *prima facie* obvious, and therefore, the Office Action’s rejection under 35 U.S.C. § 103(a) based on Moyer in view of Pflueger et al. is improper and should be withdrawn.

In the Office Action, the rejection statement concedes that the Moyer reference does not disclose, among other things, a cosmetic composition contained in a recess of a foam core. Office Action at 2. The Examiner concludes, however, that “[i]t would have been obvious . . . to employ the cosmetic composition being hold [sic] a foam recess as taught in Pflueger et al into the device of Moyer for the purpose of providing an effective and convenient way of holding the cosmetic products.” Id. at 3.

Applicant respectfully submits that the Office Action has not established that there would have been any suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the Moyer bowling ball carrier based on the teachings of Pflueger et al.’s cosmetic carrier. Rather, the Office Action asserts a mere unsupported conclusion that a person skilled in Moyer’s bowling ball art would have been motivated to provide an

effective and convenient way of holding cosmetic products. In so doing, the Office Action has simply used Applicant's own teachings against him.

A person having skill in Moyer's art relating to bowling ball carriers would not look to the teachings of Pflueger et al.'s art relating to cosmetic carriers to solve any problems. Furthermore, even hypothetically, if those references were considered, Applicant can find no support in either the Moyer reference or the Pflueger et al. reference supporting the rejection statement's unsupported allegation that a person skilled in Moyer's art relating to bowling ball carriers would have been motivated to provide "an effective and convenient way of holding [] cosmetic products" in the Moyer bowling ball carrier.

Therefore, there is no legally proper suggestion or motivation to modify the Moyer bowling ball carrier in view of the Pflueger et al. cosmetic carrier. Accordingly, each of Applicant's independent claims 1, 4, and 26 is patentably distinguishable from the Moyer and Pflueger et al. references, regardless of whether they are taken individually or in combination.

Because the Office Action has failed to set forth a *prima facie* case of obviousness based on the Moyer and Pflueger et al. references, Applicant respectfully submits that the Office Action's § 103(a) rejection of independent claims 1, 4, and 26 based on its proposed, hypothetical combination of Moyer and Pflueger et al. is improper and should be withdrawn.

II. Claim Rejection under 35 U.S.C. § 103(a) based on Moyer, Pflueger et al., and Skarne

In the Office Action, claims 10 and 16-18 were rejected under 35 U.S.C. § 103(a) based on Moyer in combination with Pflueger et al. and Skarne (U.S. Patent No. 6,055,992). Claim 16 is the only independent claim rejected under § 103(a) based on Moyer, Pflueger et al., and Skarne. For reasons at least similar to those outlined above with respect to independent claims 1, 4, and 26, the Office Action fails to establish that independent claim 16 is *prima facie* obvious based on the Moyer, Pflueger et al., and Skarne references. In particular, the Skarne reference fails to overcome the above-outlined deficiencies of the Office Action's combination of the Moyer and Pflueger et al. references. For at least these reasons, Applicant respectfully submits that the Office Action's § 103(a) rejection of independent claim 16 based on its proposed combination of Moyer, Pflueger et al., and Skarne references is improper and should be withdrawn.

III. Claim Rejection under 35 U.S.C. § 103(a) based on Moyer, Pflueger et al., and Gueret

In the Office Action, claims 3 and 6 were rejected under 35 U.S.C. § 103(a) based on Moyer in combination with Pflueger et al. and Gueret (U.S. Patent No. 5,865,194). Claims 3 and 6 depend from independent claims 1 and 4, respectively. Therefore, those claims should be allowable for at least the same reasons claims 1 and 4 are allowable.

IV. Conclusion

For at least the reasons set forth above, independent claims 1, 4, 16, and 26 should be allowable. Dependent claims 3, 5-15, and 17-25 each ultimately depend from one of independent claims 1, 4, and 16. Consequently, those dependent claims should be allowable for at least the same reasons claims 1, 4, and 16 are allowable.

Therefore, Applicant respectfully requests the reconsideration of this application, the withdrawal of the outstanding claim rejections, and the allowance of claims 1 and 3-26.

If the Examiner believes that a telephone conversation might advance prosecution, the Examiner is cordially invited to call Applicant's undersigned attorney at (571) 203-2739.

Applicant respectfully submits that the Office Action contains numerous assertions concerning the related art and the claims. Regardless of whether those assertions are addressed specifically herein, Applicant respectfully declines to automatically subscribe to them.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 6-0916.

Respectfully submitted,

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By:


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